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EXAMINER

DEBROW, JAMES J

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2176

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/828,517	Applicant(s) SEEMAN ET AL.	
	Examiner JAMES J. DEBROW	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to communications: Affidavit filed 24 Sep. 2008.

Claims 1-43 are pending in this case. Claims 1, 15, 20, 28 and 37 are independent claims.

Applicant's Response

In Applicant's response dated 24 Sep. 2008, Applicant filed an Affidavit under 37 C.F.R. 1.131 in response to the rejection dated 25 Mar. 2008. Applicant did not submit any claim amendment(s).

Response To Affidavit under 37 C.F.R. 1.131, filed 24 Sep. 2008

The Affidavit filed on 24 Sep. 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the effective filing date of the Lazareck et al. reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country both prior to, and after the effective date of the Lazareck et al. reference, up to the date of constructive reduction to practice (i.e. filing date of Application Serial No. 11/519642).

In addition, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Lazareck et al. reference to either a constructive reduction to practice or an actual reduction to practice.

Along with the said affidavit, Applicant submits Exhibit A and Exhibit B as proof of alleged assignment of the present application on November 18, 2002. Although

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Applicant has not explicitly stated such, the Examiner interprets Applicant's submission of alleged proof of assignment as an attempt to prove conception of the present invention prior to the effective date of the Lazareck et al. reference.

Without making any determination as to whether or not Applicant has proven conception based the evidence submitted, the Examiner notes, MPEP 715 discloses, *"Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application"*. The MPEP further discloses *"conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application. A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent."*

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. This proof is demonstrated with satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include attached sketches, blueprints, photographs, reproductions of notebook entries, accompanying models,

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supporting statements by witnesses, interference testimony, and/or prior submission to the USPTO of Disclosure Documents.

Therefore the Examiner concludes that for the at least reason, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Lazareck et al. (see MPEP 715.07).

Claim Objections

Claim 20 is objected to because of the following informalities: The claim contains two sub-elements labeled “(e)”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over (“Microsoft Word 2000”, Copyright 1999) (hereinafter ‘MSWord ’) in view of Lazareck et al. (Pub. No.: US 2007/0011607 A1; Effective Filing Date: Feb. 7, 2003) (hereinafter ‘Lazareck’) further in view of Nara et al. (Patent No.: US 7,203,900 B2; Filed Sep. 12, 2002) (hereinafter ‘Nara’).

In regards to independent claim 1, MSWord discloses *a computerized method for creating an electronic literary work on a computer system that includes a display, said computerized method comprising:*

- (a) *providing an archive image set which includes a plurality of digital images* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images.).
- (b) *populating a first working area of an application program with selected digital images from the archive image set, thereby to generate a contact sheet view comprising an imported image set* (Fig 3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area. As described within the specification, a contact sheet view is merely a display of the imported images. Therefore MSWord discloses generating a contact sheet view comprising an imported image set.).
- (c) *populating a second working area of the application program with selected digital images from the imported image set, thereby establishing a working image set* (Figs. 6-8; MSWord discloses populating a second document/working area or a different/second page within the same

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document of the application program with selected digital images from the imported image set, thereby establishing a working image set.).

MSWord does not expressly disclose:

- (d) *arranging the digital images which comprise said working image set into a selected storyboard sequence ;*
- (e) *associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items;*
- (f) *displaying the pairs of companion image items on the display according to said storyboard sequence.*

Lazareck teaches,

- (d) *arranging the digital images which comprise said working image set into a selected storyboard sequence (0055-0059; Lazareck teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be*

limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.).

- (e) *associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items* (0043-0051; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. In the customizable data of each story, at least one fix illustration is provided and each fixed text component may be rationally linked with the fixed illustration. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

Lazareck teaches that prior to outputting the customized book to the printer, the customized book may be available for review and edit by communicating with the data via line to the display screen(0084). Lazareck does not expressly disclose

(f) *displaying the pairs of companion image items on the display according to said storyboard sequence.*

Nara teaches,

(f) *displaying the pairs of companion image items on the display according to said storyboard sequence* (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to dependent claims 2 and 16, MSWord discloses *a computerized method whereby said archive image set is stored locally on the computer system* (p. 515-516; p. 598; Winter discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. As commonly known in the art, MSWord

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applications are typically loaded onto a user's computer, thus locally storing the ClipArt gallery.).

In regards to dependent claims 3 and 17, MSWord discloses *a computerized method whereby said archive image set is stored remotely on a remote computer system that is accessible through a suitable communications interface* (Fig. 5; Fig. 6; MSWord discloses importing clip-art using a Clip Online function in which additional clip-art is downloaded to Clip Gallery of the user's computer via the Internet.).

In regards to dependent claim 4, MSWord discloses *a computerized method according to claim 1 whereby said first and second working areas are different child windows of the application program* (Figs. 6-8; MSWord discloses a second document/working area or a different page within the same document, thus the second document/working area or a different/second page is different child window of the application program.).

In regards to dependent claim 5, MSWord discloses a computerized method according to claim 1 *whereby those digital images which populate both said first working area and said second working area appear in a common ordered arrangement* (Fig 3; Figs. 4-8; MSWord discloses a ClipArt Gallery dialog box / window, which list different categories of clip-art files are displayed alphabetically. MSWord discloses populating a first and second working area with clip art.).

In regards to dependent claim 6, MSWord discloses *a computerized method according to claim 1 whereby said working image set and said imported image set are the same* (Fig. 2; Fig. 3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. MSWord also disclose inserting archived clip art in a document, therefore the imported image set imported into the document/working area is now the image working set.).

In regards to dependent claims 7, 18, 22, 33 and 38, MSWord does not expressly disclose *a computerized method whereby the respective image data is selected from a first group of data types consisting of text-only data, non-text data, and a mixture of text-only data and non-text data.*

However, Lazareck teaches the respective image data is selected from a first group of data types consisting of text-only data, non-text data, and a mixture of text-only data and non-text data (0043-0049; Lazareck teaches the story may include both fixed and variable test, and fixed and variable images/graphics/illustrations.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

In regards to dependent claims 8, 34 and 39, MSWord does not expressly disclose *whereby said non-text data is selected from a second group of data types consisting of graphic images, photographic images and a mixture of graphic images and photographic images.*

However, Lazareck teaches *non-text data is selected from a second group of data types consisting of graphic images, photographic images and a mixture of graphic images and photographic images* (0041; 0043-0049; Lazareck teaches customizable illustrations may be referred to as variable graphics. Lazareck also teaches an image capture device such as a camera. Thus Lazareck teaches non-text images data types consisting of graphic images, photographic images and a mixture of graphic images and photographic images.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

In regards to dependent claim 9, MSWord does not expressly disclose a *computerized method according to claim 8 whereby respective image data is associated with each of the digital images in said working image set.*

However Lazareck teaches *whereby respective image data is associated with each of the digital images in said working image set* (0043-0048; Lazareck teaches

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certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

In regards to dependent claims 10, 24 and 40, MSWord in view of Lazareck does not expressly disclose *whereby the pairs of companion image items are displayed as an electronic book.*

Nara teaches *whereby the pairs of companion image items are displayed as an electronic book* (col. 25, lines 47 – col. 26, line 67; Fig. 38; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic book.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to dependent claim 11, MSWord discloses *a computerized method according to claim 1 whereby the archive image set and the imported image set are the same* (Fig. 2; Fig. 3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. MSWord also disclose inserting archived clip art in a document, therefore the archive image set and the imported image set are the same.).

In regards to dependent claims 12 and 25, MSWord discloses a Microsoft ClipArt Gallery, which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images (Fig. 2).

MSWord does not expressly disclose generating a front cover and a back cover for the electronic literary work by utilizing at least one selected digital image from said archive image set.

Lazareck teaches *generating a front cover and a back cover for the electronic literary work by utilizing at least one selected digital image from said archive image set* (0066-0067; Lazareck teaches a customized cover may be created usinging the same process as the customized book itself, by using customized illustrations, fixed illustrations or composite illustrations.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

In regards to dependent claim 13, MSWord does not expressly disclose a computerized method according to claim 1 whereby the respective image data associated with each of the digital images is text-only data.

However Lazareck teaches *the respective image data associated with each of the digital images is text-only data* (0043-0048; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

In regards to dependent claims 14, 19, 26 and 41, MSWord does not in view of Lazareck does not expressly disclose *a computerized method comprising associating a page number to each item within each of the pairs of companion image items, thereby to generate a numerical page sequence, which chronologically corresponds to the selected storyboard sequence.*

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However, Nara teaches *associating a page number to each item within each of the pairs of companion image items, thereby to generate a numerical page sequence, which chronologically corresponds to the selected storyboard sequence* (col. 1, lines 40-57; col. 3, lines 55-64; col. 11, lines 20-30; col. 25, lines 47 – col. 26, line 67; Fig. 38; Fig. 43 - Fig. 45; Nara teaches assigning page numbers to pages when the user creates a document. Nara also teaches a preview display which displays the images in the arranged order as they would appear within the electronic book. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to independent claim 15, MSWord discloses *a computerized method for creating an electronic literary work, comprising:*

- (a) *obtaining a plurality of digital images* (Fig 3; Figs. 4-5; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area.).

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- (b) *storing said digital images on a storage device as an image set* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories.).
- (c) *importing the image set from the storage device into a working project area of a display device, thereby populating the working project area with said digital images* (Fig 3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area.).
- (d) *arranging said digital images into a selected contact sheet sequence* (Fig 3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area. As described within the specification, a contact sheet view is merely a display of the imported images. Therefore MSWord discloses *arranging said digital images into a selected contact sheet sequence.*).

MSWord does not expressly disclose:

- (e) *correlating respective image data with each of said digital images, thereby to define pairs of companion image items;*
- (f) *arranging the pairs of companion image items into a selected storyboard sequence whereby the pairs of companion image items may be selectively*

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displayed according to the selected storyboard sequence.

Lazareck teaches,

- (e) *correlating respective image data with each of said digital images, thereby to define pairs of companion image items* (0043-0051; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. In the customizable data of each story, at least one fix illustration is provided and each fixed text component may be rationally linked with the fixed illustration.).
- (f) *arranging the pairs of companion image items into a selected storyboard sequence* (0055-0059; Lazareck teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.).

Lazareck teaches that prior to outputting the customized book to the printer, the customized book may be available for review and edit by communicating with the data via line to the display screen (0084). Lazareck does not expressly disclose *whereby*

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the pairs of companion image items may be selectively displayed according to the selected storyboard sequence.

Nara teaches *whereby the pairs of companion image items may be selectively displayed according to the selected storyboard sequence* (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to independent claim 20, MSWord discloses *a computer-readable medium having executable instructions for performing a method comprising:*

- (a) *providing an archive image set which includes a plurality of digital images* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images.).
- (b) *populating a first working area of an application program with selected*

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digital images from the archive image set, thereby to generate a contact sheet view comprising an imported image set (Fig 3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area. As described within the specification, a contact sheet view is merely a display of the imported images. Therefore MSWord discloses generating a contact sheet view comprising an imported image set.).

- (c) *populating a second working area of the application program with selected digital images from the imported image set, thereby establishing a working image set (Figs. 6-8; MSWord discloses populating a second document/working area or a different/second page within the same document of the application program with selected digital images from the imported image set, thereby establishing a working image set.).*

MSWord does not expressly disclose:

- (d) *arranging the digital images which comprise said working image set into a selected storyboard sequence;*
- (e) *associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items;*
- (e) *controlling an output device to display said pairs of companion image items on a display medium according to said storyboard sequence.*

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Lazareck teaches,

(d) *arranging the digital images which comprise said working image set into a selected storyboard sequence* (0055-0059; Lazareck teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.).

(e) *associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items* (0043-0051; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. In the customizable data of each story, at least one fix illustration is provided and each fixed text component may be rationally linked with the fixed illustration. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items.).

Therefore at the time of the invention it would have been obvious to one of

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ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

Lazareck teaches that prior to outputting the customized book to the printer, the customized book may be available for review and edit by communicating with the data via line to the display screen(0084). Lazareck does not expressly disclose

(f) *controlling an output device to display said pairs of companion image items on a display medium according to said storyboard sequence.*

Nara teaches,

(f) *controlling an output device to display said pairs of companion image items on a display medium according to said storyboard sequence* (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to dependent claim 21, MSWord discloses *a computer-readable medium having executable instructions according to claim 20 whereby each of said first working area and said second working area is a respective child window of the application program* (Figs. 6-8; MSWord discloses a second document/working area or a different page within the same document, thus the second document/working area or a different/second page is different child window of the application program.).

In regards to dependent claim 23, MSWord does not expressly disclose *a computer-readable medium having executable instructions according to claim 20 whereby respective image data is associated with each of the digital images in said working image set.*

However, Lazareck teaches *whereby respective image data is associated with each of the digital images in said working image set* (0043-0048; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items.).

Therefore at the time of the invention it would have been obvious to one of

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ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

In regards to dependent claim 27, MSWord in view of Lazareck does not expressly disclose *a computer-readable medium having executable instructions according to claim 20 for printing selected ones of the pairs of companion items according to a selected print sequence*.

However, Nara teaches *printing selected ones of the pairs of companion items according to a selected print sequence* (col. 17, lines 25-67; Fig. 18; Fig. 27-28; Fig. 31; Nara teaches a bookbinding printing process which is used to print selected pages of the book.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to independent claim 28, MSWord discloses *a system for enabling creation and viewing of an electronic literary work, said system comprising:*

- (a) Lazareck teaches *a composition component for creating the electronic literary work* (Fig 3; Figs. 4-5; MSWord discloses inserting clip art in a document. It has

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been established and is well known in the art, that MSWord is capable of creating an electronic literary work. Using the broadest reasonable interpretation, the Examiner concludes that any electronic document or a group of electronic documents, which consist of text or digital images, or a combination thereof would be considered as electronic literary work.).

- (b) *a storage component for storing an archive set of digital images for retrieval by said composition component* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images.).

MSWord does not expressly disclose:

- (a) *said composition component including editing capabilities which permit user-defined image data to be respectively associated with each of a plurality a digital images, thereby to define pairs of companion image items which may be arranged according to a selected storyboard sequence.*
- (c) *a viewing component for enabling the electronic literary work created by said composition component to be viewed according to said*

Lazareck teaches

- (a) *said composition component including editing capabilities which permit user-defined image data to be respectively associated with each of a plurality a digital*

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images, thereby to define pairs of companion image items which may be arranged according to a selected storyboard sequence (0043-0051; 0055-0059; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. In the customizable data of each story, at least one fix illustration is provided and each fixed text component may be rationally linked with the fixed illustration. Lazareck also teaches the customizing text data and image data regarding the story book may also be inputted using a keyboard, mouse or other input device, thus linking the components. Lazareck also teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

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Nara teaches,

(c) *a viewing component for enabling the electronic literary work created by said composition component to be viewed according to said storyboard sequence* (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*.). (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to dependent claim 29, MSWord discloses *a system according to claim 28 wherein said composition component and said storage component reside on a common computer system* (It has been established and is well known in the art that MSWord is typically installed on a client's computer.).

In regards to dependent claim 30, MSWord discloses *a system according to claim 29 wherein said composition component and said viewing component are part of a common application program* (Fig. 8; MSWord discloses composing an electronic document. MSWord also disclose the Print Preview icon, which displays the composed document. Thus, said composition component and said viewing component are part of a common application program.).

In regards to dependent claim 31, MSWord discloses *a system according to claim 28 wherein said composition component and said storage component reside on different computer systems* (Fig. 5; Fig. 6; MSWord discloses importing clip-art using a Clip Online function in which additional clip-art is downloaded to Clip Gallery of the user's computer via the Internet.).

In regards to dependent claim 32, MSWord discloses *a system according to claim 31 wherein said storage component is located on a remote computer system from said composition component, and including a suitable communications interface for accessing said storage component* (Fig. 5; Fig. 6; MSWord discloses importing clip-art using a Clip Online function in which additional clip-art is downloaded to Clip Gallery of the user's computer via the Internet.).

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In regards to dependent claim 35, MSWord in view of Lazareck does not expressly disclose *a system according to claim 28 wherein said viewing component enables the electronic literary work to be displayed as an electronic book.*

Nara teaches *wherein said viewing component enables the electronic literary work to be displayed as an electronic book* (col. 25, lines 47 – col. 26, line 67; Fig. 38; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic book.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to dependent claim 36, MSWord discloses *a system according to claim 28 wherein each of said composition component, said storage component and said viewing component is at a distinct, remote location from one another, and including suitable communications interfaces for enabling data transmission there between* (Fig. 5; Fig. 6; MSWord discloses importing clip-art using a Clip Online function in which additional clip-art is downloaded to Clip Gallery of the user's computer via the Internet.).

In regards to independent claim 37, MSWord discloses *a system for use in creating an electronic literary work, comprising:*

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- (a) *a storage device for storing a plurality of digital images as an archive image set* ((Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images.).
- (b) *a display device* (Fig. 2; Fig. 3; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes that the user's computer which is used for viewing the clip-art can be interpreted is a display device / an output device.).
- (c) *an output device* (Fig. 2; Fig. 3; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes that the user's computer which is used for viewing the clip-art can be interpreted is a display device / an output device.).
- (d) *a processor programmed to:*
 - (i) *retrieve an imported image set of digital images from said storage device* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches retrieving an imported image set of digital images from said storage device.).
 - (ii) *generate a contact sheet view from the imported image set by populating a first working area of said display device with at least some of said plurality of digital images, thereby to define a working image set* (Fig

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3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area. As described within the specification, a contact sheet view is merely a display of the imported images. Therefore MSWord generate a contact sheet view from the imported image set by populating a first working area of said display device with at least some of said plurality of digital images, thereby to define a working image set.).

MSWord does not expressly disclose:

(iii) *generate a storyboard view by arranging digital images within the working image set into a selected storyboard sequence on said display device;*

(iv) *associate respective image data with at least some of the digital images in said storyboard viewing sequence, thereby to define pairs of companion image items; and*

(v) *control at least one of said display device and said output device to display said pairs of companion image items to the storyboard sequence.*

Lazareck teaches,

(iii) *generate a storyboard view by arranging digital images within the working image set into a selected storyboard sequence on said display*

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device (0055-0059; Lazareck teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.)).

(iv) *associate respective image data with at least some of the digital images in said storyboard viewing sequence, thereby to define pairs of companion image items; and* (0043-0051; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items.)).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

Nara teaches

(v) *control at least one of said display device and said output device to display said pairs of companion image items to the storyboard sequence.*

(col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to independent claim 42, MSWord discloses *a system for use in creating an electronic literary work, comprising:*

(a) *storage means for storing a plurality of digital images as an archive image set* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images.).

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- (b) *display means* (Fig. 2; Fig. 3; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes that the user's computer which is used for viewing the clip-art can be interpreted is a display device / an output device.).
- (c) *output means* (Fig. 2; Fig. 3; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes that the user's computer which is used for viewing the clip-art can be interpreted is a display device / an output device.).
- (d) *processing means operative to:*
 - (i) *retrieve an imported set of the digital images from said storage means* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches retrieving an imported image set of digital images from said storage device.).
 - (ii) *generate a contact sheet view from imported image set by populating a first working area of said display means with at least some of said plurality of digital images, thereby to define a working image set* (Fig 3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area. As described within the specification, a contact sheet view is merely a display of the

imported images. Therefore MSWord generate a contact sheet view from the imported image set by populating a first working area of said display device with at least some of said plurality of digital images, thereby to define a working image set.).

MSWord does not expressly disclose:

- (iii) *with the generate a storyboard view by arranging digital images working image set into a selected storyboard viewing sequence on said display means;*
- (iv) *associate respective image data with at least some of the digital images in said storyboard viewing sequence, thereby to define pairs of companion image items; and*
- (v) *control at least one of said display means and said output means to display said pairs of companion image items to the storyboard viewing sequence.*

Lazareck teaches

- (iii) *with the generate a storyboard view by arranging digital images working image set into a selected storyboard viewing sequence on said display means* (0055-0059; Lazareck teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of

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the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.).

(iv) associate respective image data with at least some of the digital images in said storyboard viewing sequence, thereby to define pairs of companion image items (0043-0051; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Lazareck with MSWord for the benefit of producing customized books (0014).

Nara teaches

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(v) *control at least one of said display means and said output means to display said pairs of companion image items to the storyboard viewing sequence* (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

In regards to independent claim 43, MSWord discloses *an electronic literary work produced by a method comprising:*

- (a) *providing an archive image set which includes a plurality of digital images* (Figs. 2-3; MSWord discloses a Microsoft ClipArt Gallery which stores a plurality of digital images under different categories. Thus MSWord teaches providing an archive image set, which includes a plurality of digital images.).
- (b) *populating a first working area of an application program with selected*

digital images from the archive image set, thereby to generate a contact sheet view comprising an imported image set (Fig 3; Figs. 4-5; Figs. 11-12; MSWord discloses inserting clip art in a document. Using the broadest reasonable interpretation, the Examiner concludes the working document is analogous to the working area. As described within the specification, a contact sheet view is merely a display of the imported images. Therefore MSWord discloses generating a contact sheet view comprising an imported image set).

- (c) *populating a second working area of the application program with selected digital images from the imported image set, thereby establishing a working image set (Figs. 6-8; MSWord discloses populating a second document/working area or a different/second page within the same document of the application program with selected digital images from the imported image set, thereby establishing a working image set.).*

MSWord does not expressly disclose:

- (d) *arranging the digital images which comprise said working image set into a selected storyboard sequence;*
- (e) *associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items; and*
- (f) *displaying the pairs of companion image items on the display according to*

said storyboard viewing sequence.

Lazareck teaches,

- (d) *arranging the digital images which comprise said working image set into a selected storyboard sequence* (0055-0059; Lazareck teaches customizing image data through manipulation of the customizing image data. Lazareck teaches customized image data may consist of digital images. The manipulation of the digital image could range greatly in generating the customized illustration. At the time of the invention it would have been obvious to one of ordinary skill in the art that manipulation of digital images for creating a customized book would include but not be limited to arranging the digital images which comprise said working image set into a selected storyboard sequence.).
- (e) *associating respective image data with at least some of the digital images in said working image set, thereby to define pairs of companion image items* (0043-0051; 0084; Lazareck teaches certain fixed and variable text components making up the story text and the fixed illustration (images) component are automatically linked. In the customizable data of each story, at least one fix illustration is provided and each fixed text component may be rationally linked with the fixed illustration. Alternatively, fix illustrations and fixed text components can be separately selected. Thus, Lazareck teaches associating respective image data with at least some of

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the digital images in said working image set, thereby to define pairs of companion image items.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine MSWord and Nara with Lazareck for the benefit of producing customized books (0014)

Nara teaches,

(f) *displaying the pairs of companion image items on the display according to said storyboard viewing sequence* (col. 25, lines 47 – col. 26 , line 67; Fig. 43 - Fig. 45; Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic *literary work*. Thus Nara teaches displaying the pairs of companion image items on the display according to said storyboard sequence.).

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to combine Nara with MSWord in view of Lazareck for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability (col. 29, lines 53-56).

Note

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to

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be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See MPEP 2123.

Response to Arguments

Applicant's arguments filed 24 Sep. 2008 have been carefully and fully considered, but are not persuasive.

The examiner's response to Applicant's filing of Affidavit under 37 C.F.R. 1.131 has been addressed in paragraph 6 of the instant Office Action.

Applicant submits no substantial arguments on the merits of the instant rejections as applied to the Lazareck reference. Accordingly, no examiner response is deemed necessary.

Applicant states that claim objection set forth in the previous office action has been corrected (Response, page 1). However Applicant failed to submit a copy of the amended claim(s) identifying such correction, thus the previous claim objection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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